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KING, BRADLEY T

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY JAMES BAXTER

Appeal 2009-013566
Application 10/709,743
Technology Center 3600

Before: WILLIAM F. PATE III, STEVEN D.A. MCCARTHY, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFI

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a deformation element for a vehicle dashboard. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An energy absorbing structure, comprising:
a first deformation member having a curved shape with at least first and second opposing radii of curvature in the direction of a deformation axis forming a generally “S” shape; and
a second deformation member interconnected with said first deformation member such that said first and second deformation members intersect to define at least first and second deformation cavities between said deformation members, at least one of said deformation cavities operable to close during application of a load in the direction of said deformation axis.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

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| Almefelt | US 5,951,045 | Sep. 14, 1999 |
| Bair | US 6,170,872 B1 | Jan. 9, 2001 |
| Pomero | WO 93/23626 | Nov. 25, 1993 |

REJECTIONS

Claims 1-30 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Ans. 3.

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Claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26 and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bair. Ans. 4.

Claims 12-15, 20 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pomero. Ans. 4.

Claims 7-9, 17-19 and 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bair and Almefelt. Ans. 5.

Claims 3, 4, 13, 14, 21 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bair and Pomero. Ans. 5.

OPINION

The rejection of claims 1-30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. *See, e.g., In re Lukach*, 442 F.2d 967, 968-69 (CCPA 1971). This is not an *in haec verba* requirement. *See, e.g., Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Thus, the Examiner's argument that "[t]he original disclosure fails to use the 'generally S shape' terminology" is unpersuasive. Ans. 6. Contrary to the Examiner's assertion, paragraph [0024] of the Specification refers to the cavities as being diamond shaped and does not refer to the deformation member as being diamond shaped. Br. 6; *see* Ans. 3. Appellant is not precluded from using the same language in the claims that is used by Appellant to describe the prior art. A rejection under 35 U.S.C. § 112 second paragraph, rather than first paragraph, is appropriate if the scope of the claims is unclear, as alleged by the Examiner. No rejection under 35 U.S.C. § 112 second paragraph is before us for review.

An S-shape is depicted in figures 2 and 3 and described in paragraph [0022] of the Specification as opposed double curves. Thus, the Specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath Inc.*, 935 F.2d at 1563-64. Accordingly, the rejection under U.S.C. § 112 first paragraph as failing to comply with the written description requirement must be reversed.

The rejections of claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26 and 28-30 as being anticipated by Bair; of claims 7-9, 17-19 and 23-25 as being unpatentable over Bair and Almefelt; and of claims 3, 4, 13, 14, 21 and 27 as being unpatentable over Bair and Pomero, are affirmed.

Appellant's sole contention regarding the Examiner's application of Bair, alone or in combination with a secondary reference, is that Bair fails to disclose the claimed "'S'-shape." Br. 6-10. Appellant contends that Bair only discloses opposing "C" shaped members. Br. 6-7. Where, as in Figure 4 of Bair, those C-shaped members are arranged in opposed configuration, welded end-to-end along the deformation axis, they are reasonably read as a deformation member having an "'S' shape." *See* Bair col. 2, ll. 8-9, 41-44; col. 4, ll. 14-19; fig. 4. There is no distinction between such a structure and the opposed double curved structure described by Appellant's Specification. The claims do not preclude the member from being formed from more than one piece. Ans. 7-8. Appellant does not specifically address the Figure 4 embodiment of Bair applied by the Examiner. For these reasons, Appellant's argument that the Examiner erred by finding that Bair discloses a deformation member having an "'S' shape" is unpersuasive. Accordingly, the rejections of claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26 and 28-30 as

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being anticipated by Bair, of claims 7-9, 17-19 and 23-25 as being unpatentable over Bair and Almefelt, and of claims 3, 4, 13, 14, 21 and 27 as being unpatentable over Bair and Pomero, are affirmed.

The rejection of claims 12-15, 20 and 21 as being anticipated by Pomero is reversed.

Appellant's sole contention regarding the Examiner's application of Pomero is that Pomero's figure "8" shape is not reasonably read as two "S" shaped members. We agree. As discussed above and by the Examiner, the claims do not preclude the member from being comprised of multiple elements welded together as in Bair. Ans. 8-9. However, the Examiner's reading of Pomero requires arbitrary portions of the modules 1 defined only by the Examiner to form the claimed deformation member having an "S" shape. Since one of ordinary skill in the art would not interpret these arbitrary portions as the claimed deformation member having an "'S' shape" the Examiner's interpretation is unreasonable. We are therefore constrained to reverse the rejection of independent claims 12 and 20, and dependent claims 13-15 and 21, as being anticipated by Pomero.

DECISION

The rejection of claims 1-30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejections of claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26 and 28-30 as being anticipated by Bair; of claims 7-9, 17-19 and 23-25 as being unpatentable over Bair and Almefelt; and of claims 3, 4, 13, 14, 21 and 27 as being unpatentable over Bair and Pomero, are affirmed.

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The rejection of claims 12-15, 20 and 21 as being anticipated by Pomero is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

nhl

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